

Appln. Serial No. 10/645,489
Amendment Dated August 22, 2007
Reply to Office Action Mailed May 22, 2007

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REMARKS

In the Office Action dated May 22, 2007, claims 1, 2, 9, and 13 were objected; claim 12 was rejected under 35 U.S.C. § 101; claim 12 was rejected under § 112, ¶ 1; and claims 1-8, 10, 11, 13, and 14 were rejected under § 103 over U.S. Patent No. 6,901,052 (Buskirk) in view of U.S. Patent No. 6,618,356 (Bonaventure).

Applicant acknowledges the indication that claim 9 contains allowable subject matter.

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CLAIM OBJECTION

The Office Action objected to use of the term "adapted to" in various claims. Applicant respectfully traverses this objection.

Contrary to the assertion in the Office Action, courts have approved the use of "adapted to" as providing structural limitations. See *In re Venezia*, 189 U.S.P.Q. 149, 151-152 (C.C.P.A. 1976) ("Rather than being a mere direction of activities to take place in the future, this language ["adapted to"] imparts a structural limitation"). The court in *In re Venezia* stated that there is "nothing wrong in defining the structures of the components ... in terms of the interrelationship of the components." *Id.* at 152. The case cited in the Office Action, *In re Hutchinson*, 69 U.S.P.Q. 138 (C.C.P.A. 1946), involved use of "adapted" in defining a field of use. The clause at issue in *In re Hutchinson* is "an article of manufacture, adapted for use in the fabrication of a metal template or the like," which was provided in the preamble of the claim at issue to define a field of use of the claimed article. In contrast, the claims of the present application recite "adapted to" to define the interrelationship between components of the claimed invention, which has been held by cases as imparting structural limitation.

In view of the foregoing, withdrawal of the objection is respectfully requested.

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REJECTION UNDER 35 U.S.C. § 101

Claim 12 was rejected under § 101 as being directed to non-statutory subject matter. To address the rejection, the preamble of claim 12 has been amended to recite a “computer-readable storage medium” that contains computer-executable instructions that when executed by a processor in an upstream services policer cause the processor to perform the tasks recited in claim 12. As noted by the M.P.E.P., when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. M.P.E.P. § 2106.01 (8th ed., Rev. 5), at 2100-17. In this case, contrary to the assertion made in the Office Action, the material recited in claim 12 constitutes *functional* descriptive material, since functions are realized by the elements of claim 12. Examples of *non-functional* descriptive material include music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship. *Id.* at 2100-18. In the present case, the recited elements of claim 12 refer to tasks performed by computer-executable instructions when executed by a processor in an upstream services policer. Therefore, it is respectfully submitted that claim 12 is directed to statutory subject matter.

Withdrawal of the § 101 rejection, and the associated § 112, ¶ 1 rejection, is respectfully requested.

Since no prior art rejection was asserted against claim 12, allowance of claim 12 is respectfully requested since the § 101 rejection has been overcome.

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REJECTION UNDER 35 U.S.C. § 103

Independent claim 14 has been amended to recite subject matter similar to that recited in claim 9. Therefore, it is believed that claim 14 is now in condition for allowance.

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1 over Buskirk and Bonaventure for at least the reason that a hypothetical combination of Buskirk and Bonaventure does not teach or hint at all elements of claim 1.

Although the Office Action cited to various passages of Buskirk and Bonaventure in rejecting claim 1, it is noted that the Office Action did not discuss how a key element of claim 1 was disclosed or hinted at by Buskirk and Bonaventure. Specifically, claim 1 recites an upstream services policer to receive feedback from the downstream services policer. There is absolutely no hint anywhere in the hypothetical combination of Buskirk and Bonaventure of an upstream services policer as recited in claim 1 that is able to receive feedback from the downstream services policer. As depicted in Fig. 4 of Buskirk (also cited by the Office Action), components of an ingress processing system include a policer 404 as well as a classifier 402 and an editor 406. There is only one policer; there is no teaching in Buskirk of multiple policers, as recited in claim 1, which was conceded by the Office Action. See 5/22/2007 Office Action at 6. Thus, it would be impossible for Buskirk to have an upstream services policer that transmits a traffic unit to a downstream services policer, and that *also* receives *feedback* from the downstream services policer.

Bonaventure does not remedy the defect in Buskirk regarding teaching the elements of claim 1. Bonaventure discloses a first determiner DET1 that determines a lower order identifier of a received packet, and a second determined DET2 that determines a higher order identifier of the received packet. Bonaventure also discloses two controllers, CTRL1 and CTRL2, that execute a lower order conformance checking and a higher order conformance checking, respectively. However, there is absolutely no indication of the lower order conformance controller CTRL1 transmitting a traffic unit to the higher order conformance controller CTRL2, in combination with the lower order conformance controller CTRL1 receiving feedback from the higher order conformance controller CTRL2.

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Since the hypothetical combination of the references does not disclose or hint at all elements of claim 1, the *prima facie* case of obviousness is defective for at least this reason.

Moreover, no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of the references. See *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007). In the Background section of Buskirk, Buskirk criticized the use of "multiple specialized circuits [that] are required to accommodate packets of each packet protocol that might traverse the network switch, router, bridge, or other intermediate system between the source and destination." Buskirk, 3:34-41. Instead, Buskirk proposed "a method and apparatus for commonly policing packets of multiple transmission protocols." Buskirk, 3:42-44. As depicted in Fig. 4 of Buskirk, a single policer is used to implement policing for multiple flows of multiple protocols. As taught by Buskirk, its arrangement is a "tightly coupled arrangement facilitated by the integration into a common chip." Buskirk, 9:42-47. The policing engine of Buskirk multiplexes multiple flows into a single stream, and applies policing on that single stream. Buskirk, 9:59-66.

In other words, rather than provide a hint or suggestion of the claimed subject matter, Buskirk actually would have led a person of ordinary skill in the art away from the claimed invention by teaching that it would be more desirable to integrate policing functions into a single policer. In view of the foregoing, a person of ordinary skill in the art would clearly not have been prompted to combine the teachings of Buskirk and Bonaventure to achieve the claimed subject matter.

A *prima facie* case of obviousness has not been established with respect to claim 1 for at least this additional reason.

Independent claim 10 is allowable for similar reasons as claim 1. Moreover, claim 10 recites that feedback received from the downstream services policer is to cause the upstream services policer to *modify* analysis by the upstream services policer of further received traffic units. There is absolutely no hint provided anywhere in Buskirk and Bonaventure of this additional feature of claim 10.

Independent claim 12 is allowable over the cited references for similar reasons as claim 10.

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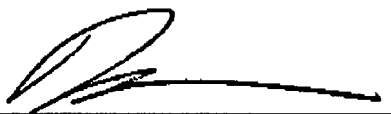
Amended independent claim 13 is also non-obvious over Buskirk and Bonaventure, since the asserted combination of the references do not disclose or hint at a second upstream services policer that analyzes a traffic unit according to a *second class* of service and that amends the traffic unit to indicate that the traffic unit is a traffic unit for a *first class* of service *rather than the second class of service*.

Dependent claims, including newly added dependent claims 15-21, are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0180US).

Respectfully submitted,

Date: 8-22-2007


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